

DOCKET NO.: CP245
Application No.: 10/660,058
Office Action Dated: December 18, 2006

PATENT

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REMARKS

Claims 1-44, all pending claims, are subject to a restriction requirement under 35 U.S.C. §121. The Examiner has required the Applicants to elect one of the allegedly distinct inventions, classified as Groups I and II. Reconsideration of the restriction requirement in view of the following remarks is respectfully requested.

Applicants provisionally elect Group I with traverse, namely, claims 1-10, 18 and 20-44.

Further, Applicants provisionally elect the species of claim 9: a pharmaceutical unit dose consisting essentially of 340 mg of modafinil.

Applicants reserve the right to place the remainder of the subject matter in future divisional applications.

Traverse:

Applicants respectfully traverse the restriction requirement. The restriction requirement is improper because the Patent Office has not shown that examining all the claims would constitute a serious burden.

M.P.E.P. §803 provides:

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

Thus, for a restriction requirement to be valid, the Patent Office must establish the following two criteria: (1) the existence of independent and distinct inventions (35 U.S.C. §121); and (2) that the search and examination of the entire application cannot be made without serious burden (M.P.E.P. §803).

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The Patent Office has not shown the second requirement has been met. It is believed that the subject matter of Groups I and II are closely related, and examination of Group I will therefore inevitably require searching of subject matter common to all the groups. Indeed the Office Action has identified the subject matter of each of the groups as being in the same class/subclass. In particular, a search of the pharmaceutical compositions of Group I will also include their methods of use (Group II), as shown in the Class Definition for class 514:

SCHEDULE OUTLINE OF CLASS 514

The schedule is divided into a number of parts, each of which is distinct and provides for different types of subject matter. The following is a breakdown of the major areas and indicates the type of subject matter provided therein.

(A) Subclasses 1-768 provide for the subject matter proper under Class 424 containing a designated organic active ingredient (DOAI), methods of making such compositions and **methods of using such compositions**. Also included herein are method of using a specified DOAI. [emphasis added].

Accordingly, the subject matter of Groups I and II can be searched and examined in a single application, resulting in economies to the Patent Office, as well as the Applicant.

Conclusion:

Accordingly, Applicants respectfully request that the Restriction Requirement be reconsidered and that the claims encompassed in the application be examined.


In view of the above, it is believed that all the claims are in form for allowance, and an early notification to that end is respectfully requested.

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Respectfully submitted,

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Eric K. Voelk
Registration No. 45,185

CEPHALON, Inc.
41 Moores Road
PO Box 4011
Frazer, PA 19355
Telephone: 610-883-5679
Telefax: 610-727-7651